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Applicant(s): Michael J. Shebek

Docket No.

APC-P002.01

Application No.
10/735,144

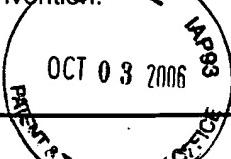
Filing Date
12/12/2003

Examiner
Robert M. Fetsuga

Customer No.
27268

Group Art Unit
1570

Invention: **UNIVERSAL TRACK AND COPING ASSEMBLY FOR POOL COVERS**



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TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
APC-P002.01

Re Application Of: Michael J. Shebek

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/735,144	12/12/2003	Robert M. Fetsuga	27268	3751	1570

Invention: UNIVERSAL TRACK AND COPING ASSEMBLY FOR POOL COVERS

COMMISSIONER FOR PATENTS:

Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

August 3, 2006

- Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: \$250.00

- A check in the amount of the fee is enclosed.
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Signature

Dated: October 3, 2006

Kevin R. Erdman, Reg. No. 33,687

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300 North Meridian Street, Suite 2700

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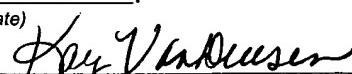
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Michael J. Shebek)
Application No. 10/735,144) Group Art Unit: 3751
Filed: December 12, 2003)
Title: UNIVERSAL TRACK AND)
COPING ASSEMBLY FOR)
POOL COVERS) Examiner: Robert M. Fetsuga

APPELLANT'S BRIEF

Hon. Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed herewith is the Brief of Appellant in the above-identified case, submitted pursuant to 37 C.F.R. § 41.37. The required fee in the amount of \$250.00 is enclosed. If the enclosed remittance is insufficient, please charge Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,

Kevin R. Erdman
Registration No. 33,687

Attorney for Appellant

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of: Michael J. Shebek)
Application No. 10/735,144) Group Art Unit: 3751
Filed: December 12, 2003)
Title: UNIVERSAL TRACK AND)
COPING ASSEMBLY FOR)
POOL COVERS) Examiner: Robert M. Fetsuga

APPELLANT'S BRIEF

Hon. Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This appeal is taken from the Examiner's decision dated July 3, 2006, finally rejecting Claims 1-17, by way of a Notice of Appeal filed August 3, 2006.

(1) REAL PARTY IN INTEREST

The real party in interest is Automatic Pool Covers, Inc. ("Assignee") by virtue of the Assignment dated December 10, 2003 recorded at Reel 01481, Frame 0384 on December 12, 2003.

(2) RELATED APPEALS AND INTERFERENCES

Neither the Appellant, Appellant's representatives, nor the Assignee know of any other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) STATUS OF CLAIMS

Pending: 1-17

Withdrawn: 18-19

Allowed: none

Rejected: 1-17

On Appeal: 1-17

(4)

STATUS OF AMENDMENTS

Two Amendments have been submitted to the Office. The first, dated July 7, 2005, amended claims 1, 11, and 12, and paragraphs 0037 and 0045 of the specification, and withdrew claims 18 and 19. The second, dated August 5, 2005, amended claims 1, 11, and 12.

(5)

SUMMARY OF THE INVENTION

The present invention provides a universal track and coping assembly for use with different commercially available swimming pool covers or suitable new pool covers. The universal track and coping assembly includes a coping body and a reversible track for retaining side edges of a pool cover. The reversible track is insertable within a slot of the coping body in two orientations. In each orientation, the track is configured to retain or operate a different construction of the pool cover. [p. 4, ¶ 0008, ll. 2-7]¹

The reversible track defines a first channel and a second channel for receiving and retaining a rope attached to each edge of the pool cover. A first channel defines a first opening and a second channel defines a second opening. The first and the second openings face opposite directions. When the reversible track is inserted into the coping slot, either the first or the second opening may face in the same direction as the slot opening. [p. 5, ¶ 0013, ll. 5-10]

The second channel of the reversible track may further define a rope passage and a passage opening within the second channel. The passage opening is in communication with the

¹ Please note that all page, paragraph, and line numbers refer to the specification in the application as filed on December 12, 2003, and *not* to the page, paragraph, and line numbers in the specification as published on July 1, 2004 (Pub. No. US 2004/0123380 A1).

second channel opening. The first channel and the rope passage are configured to receive the rope attached to the pool cover. Either the first channel or the rope passage may receive a first leg of the rope, which is directly associated with the edge of the cover, or the return leg of the rope. The second channel is also configured for receiving a portion of a slider attached to a pool cover. [p. 5, ¶ 0014, ll. 11-17]

As shown in Figures 2-3, universal track and coping assembly 20 includes coping 40 defining slot 42 having reversible track 60 inserted therein. Universal track and coping assembly 20 may also include at least one insert plate 90. Figure 2 depicts reversible track 60 inserted in slot 42 in a first orientation, having first channel opening 65 faces back wall 45, and second channel opening 71 faces in the same direction as slot opening 46. First ledge 63 or track tab 67 is interlocked with coping tab 48 within space 49 of slot 42. Figure 3 depicts reversible track 60 inserted in slot 42 in a second orientation, having second channel opening 71 facing back wall 45 of slot 42, and first channel opening 65 facing in the same direction as slot opening 46. Second ledge 76 is interlocked with coping tab 48 within space 49 of slot 42. [p. 9, ¶ 0036, ll. 18-20; p. 11, ¶ 0044, 20 – p. 12, ¶ 0044, ll. 1-2]

As depicted in Figure 4, slot 42 of coping 40 is defined by first inner wall 43, second inner wall 44, end wall 45, and slot opening 46. First inner wall 43 defines coping tab 48 projecting towards second inner wall 44. The shape and sizes of slot 42 may vary. For example, as demonstrated in Fig 4, slot 42 is depicted as having a rectangle cross section, having first inner wall 43 positioned on the top side of slot 42, and second inner wall 44 positioned on the bottom side of slot 42. [p. 10, ¶ 0037, ll. 1-6]

In Figure 5, reversible track 60 defines first head 61 and second head 62. First head 61 defines first channel 64 having opening 65. First head 61 also defines top wall 66 having first

ledge 63 projecting from top wall 66. First ledge 63 may be shaped as track tab 67. First head 61 may also define second track tab 68 having front surface 69. Second head 62 is connected to first head 61, having space 82 therebetween. Second head 62 defines top wall 78 and ledge 76 projecting from top wall 78. Second head 62 further defines second channel 70 having second channel opening 71. Second channel 70 may include rope passage 74 having passage opening 75 open toward second channel opening 71. [p. 10, ¶ 0039, ll. 12-19]

In Figure 7, reversible track 60 is inserted in slot 42 in the first orientation, having first head 61 facing back wall 45 of coping 40, and second head 62 facing in the same direction as slot opening 46. Second head 62 defines second channel 70 having rope passage 74 for receiving first construction 18 of pool cover 30. Rope 36 defines first leg 37 running along the length of cover 34 and return leg 38. First leg 37 may extend beyond the length of cover sheet 34 to wind around pulley 101 disposed at second end 12 of pool 10 (see Figure 1). Pulley 101 may rotate in one direction to pull on first leg 37 while releasing return leg 38 in order to pull cover sheet 34 towards second end 12 of pool 10 for a closing position. Pulley 101 may rotate in an opposite direction to pull on leg 38 while releasing leg 37 when cover sheet 34 retracts for an opening position. [p. 12, ¶ 0050, ll. 15-22 – p. 13, ¶ 50, 1-6]

In Figure 8, reversible track 60 is inserted in slot 42 in the second orientation, having first head 61 facing in the same direction as slot opening 46, and second head 62 facing back wall 45 of coping 40. First head 61 defines first channel 64. Received therein is second construction 19 of pool cover 30. In alternative construction 19, cover 30 has edges 32, each attached to rope 36. Rope 36 has first leg 37 attached to cover sheet 34, and return leg 38. Alternative construction 19 does not have a slider or lead guide. When pool cover 30 is extended along pool

10 (see Figure 1), first leg 37 is pulled along first channel 64 and return leg 38 is pulled in an opposite direction through rope passage 74. [p. 14, ¶ 0051, ll. 10-17]

Universal track and coping assembly 20 of the present invention provides pool installers with a flexibility in using different types of pool covers, without having to purchase or stock up many different combinations of track and copings. Similarly, manufacturers do not need to manufacture, transport, or store different copings and tracks for different constructions of pool covers. [p. 15, ¶ 0054, ll. 9-13]

(6)

GROUNDS OF REJECTION

- I. The affidavit of Bruce Holmes overcomes the Examiner's rejection of claims 1 and 6-11 under §112, ¶ 1.
- II. The Last Reference does not support a rejection under §102(a) or (e).

(7)

GROUPING OF CLAIMS

Claims 1 and 6-11 stand or fall together under 35 U.S.C. § 112, ¶ 1.

Claims 1-17 stand or fall together under 35 U.S.C. § 102(a)/(e).

(8)

ARGUMENT

- I. The affidavit of Bruce Holmes overcomes the Examiner's rejection of claims 1 and 6-11 under §112, ¶ 1.

When an Examiner rejects a claim for lack of enablement under 35 U.S.C. § 112, ¶ 1, the burden is on the Examiner to make out a *prima facie* case showing a lack of enablement. *Ex Parte Carmen I. Huber*, 1997 WL 1883867, *2 (Bd. Pat. App. & Interf. 1997). To do this, the Examiner must "advanc[e] acceptable reasoning inconsistent with enablement." *Ex Parte Nathan Feldstein and Deborah J. Lindsay*, 2002 WL 43699, *2 (Bd. Pat. App. & Interf. 2002). If the Examiner carries this burden, it then becomes the responsibility of the Appellant to "present persuasive arguments, supported by suitable proofs where necessary, that one skilled in the art would be able to make and use the claimed invention using the disclosure as a guide." *Ex*

Parte Carmen I. Huber, 1997 WL at *2. Evidence supporting this rebuttal can include affidavits.

See, e.g., Ex Parte Nathan Feldstein and Deborah J. Lindsay, 2002 WL at *2; see also 37 C.F.R. § 1.132.

During the prosecution of the above-titled application, the Examiner first rejected claims 1 and 6-11 without giving any substantive explanation for his rejection. He merely stated,

Claims 1 and 6-11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a track and coping assembly with a [sic] insert plate, does not reasonably provide enablement for a track and coping assembly without a [sic] insert plate. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

See Office Action, dated April 7, 2005, p. 5, ¶ 6. These conclusory statements do not "advance acceptable reasoning inconsistent with enablement;" thus, the Examiner did not make out a *prima facie* case of nonenablement, as required by the law. Nevertheless, Appellant rebutted the Examiner's unsupported conclusion by pointing out paragraph 0036 of the application, which indicated that insert 90 is permitted but not required, as well as Figs. 4 and 5 of the application. Appellant stated, "it is inherent that height b₁ of reversible track 60 may be equal to height b of slot 42 of coping 40 allowing reversible track 60 to couple to coping 40 without insert 90." Response to Office Action, dated July 7, 2005, p. 7. Thus, the Appellant reasoned, "it is an obvious design choice for one having ordinary skill in the art" to construct a coping with slot having a height substantially similar to or equal to the height of the reversible track – thereby creating a coping system without an insert. *Id.*

The Examiner then sent another Office Action, this time *finally* rejecting claims 1 and 6-11. *See* Office Action dated Sept. 9, 2005, p. 3. In it, he repeated his generic rejection paragraph, and added a statement that "there is no teaching in paragraph 0036 concerning tab 48.

Claim 1 recites a tab (ln. 5). Paragraphs 0040 and 0042 indicate the requirement of plate 90 to lock the track in the coping when the coping includes such a tab." *Id.* at p. 2-3.² The Examiner offered no explanation of why he thought this argument compelling – or even relevant – as to nonenablement. In addition, the Examiner was incorrect in his tab-related statements. In the specification and drawings, tab 48 in coping 40 projects from "either one of said inner wall and said opposite inner wall" in claim 1. However, as can be seen in a review of paragraphs 0040 and 0042, there is no explicit requirement that a plate be used when tab 48 is included in the coping. In fact, tab 48 is not mentioned at all in either paragraph. The only tabs mentioned in either paragraph are tabs 67 and 68 (in paragraph 0040). Tabs 67 and 68 are tabs in the reversible track 60, not in the coping 40, and thus neither tab 67 nor tab 68 is the tab to which claim 1 refers.

Furthermore, the Examiner failed to acknowledge the Appellant's citation of Figs. 4 and 5 in support of the enablement of one skilled in the art to construct a coping system without an insert. Figure 4 clearly depicts tab 48, *and does not depict insert 90*, thus allaying any concerns the Examiner could have had regarding the need to demonstrate use of a tab, such as tab 48, in an insert-less embodiment of the invention. The Examiner was silent on the Appellant's arguments regarding the disclosure of Figs. 4 and 5, and thus, Appellant can only presume that the Examiner has agreed that Figs. 4 and 5 depict quite clearly a coping system without an insert.

In his response to the final Office Action of September 9, the Appellant submitted a Request for Continuing Examination on December 7, 2005. In support of his enablement arguments, the Appellant submitted the affidavit of Bruce Holmes, who has 21 years of

² Appellant is in no way admitting that this auxiliary statement by the Examiner discharges the Examiner's burden of making out a *prima facie* case of nonenablement.

experience in installing and servicing pools. See Declaration of Bruce Holmes ("Holmes Declaration,"), Request for Continuing Examination dated Dec. 7, 2005, ¶ 1. He stated that, "typically, *but not exclusively*, an insert plate is used as a locking mechanism... However, it is also understood that in some environments an insert plate would *not* be desired, in which case the material thicknesses would be varied to obviate the need for an insert plate." Holmes Declaration, ¶ 3 (emphases added). Mr. Holmes declared, "it is my opinion that an artisan of ordinary skill in the pool equipment installation industry would recognize that the invention of the above-identified patent application could be implemented with or without an insert plate."

Id.

The Examiner gave no weight to this evidence. Instead, he merely repeated his erroneous statement that paragraphs 0040 and 0042 require the use of an insert plate when the coping includes tab 48 as recited in claim 1. Office Action dated Feb. 14, 2006, p. 2.³ He quoted Mr. Holmes's statement that "the material thicknesses would be varied to obviate the need for an insert plate," and stated, "[t]his bald statement fails to address the recitation of the tab in claim 1." *Id.*

Appellant is at a loss to understand the Examiner's argument. Mr. Holmes stated that "different sizes and shapes of *tracks* in coping may be used, and material thicknesses in each may be varied." Holmes Declaration, ¶ 3 (emphasis added). Mr. Holmes thus refers to varying the thickness of track 60 as a sufficient solution to the "no insert plate" situation, without needing also to vary the thickness of coping 40. As tab 48 protrudes from one of the inner walls of coping 40, *see Fig. 4*, it is irrelevant to the person of ordinary skill's ability to vary the thickness

³ Again, paragraphs 0042 and 0040 do *not* require the use of an insert plate when the coping includes tab 48, because tab 48 is never even mentioned in these paragraphs.

of track 60 when an insert plate is not used. Furthermore, as explained above, there is no requirement in either paragraph 0040 or 0042 that insert plate 90 be used in conjunction with tab 48.⁴ The Holmes Declaration cannot be deprived of probative value simply because the Examiner would have preferred that the person of ordinary skill in this art take a different approach to implementing a plateless track and coping system.

The Appellant duly submitted an Office Action Response on May 15, 2006, stating that the Examiner failed to take into account the entirety of the Holmes Declaration in maintaining his rejection of claims 1 and 6-11. *See Response to Office Action dated May 15, 2006.* The Examiner then sent a final Office Action on July 3, 2006, which gave no reasons for maintaining the rejection – it simply stated that "the declaration was fully considered, and its probative value weighed accordingly." Office Action, dated July 3, 2006. The Appellant then filed a Notice of Appeal on August 3, 2006.

As explained above, the Appellant has rebutted (several times) any *prima facie* case of nonenablement that the Examiner could have made.⁵ Therefore, Appellant respectfully requests that the Examiner's rejection of claims 1 and 6-11 be withdrawn.

II. The Last Reference does not support a rejection under §102(a) or (e).

The Examiner has rejected claims 1-17 over U.S. Patent No. 6,496,990 ("the Last Reference") for failure to meet the requirements of 35 U.S.C. §102 (a) and (e). He argues that each and every element of each and every claim in the Application is taught in the Last Reference. However, as the Appellant has explained, the Examiner's assessment is incorrect.

⁴ Appellant can only assume that the Examiner has confused tab 48, which is on coping 40, with either of tabs 67 or 68, which are on track 60.

⁵ *But see n. 2, supra.*

Independent claims 1 and 12 are deserving of patent protection – and, thus, so are all claims depending from them.

The Examiner and the Appellant have disagreed regarding both the scope of the Application's claims and the corresponding applicability (or non-applicability) of the Last Reference to those claims. The Examiner has argued that the claims of the Application cannot be understood to require channels having differing configurations, "as the presence of such limitation has neither been found in the 'claims' by the Examiner, nor pointed out by the Applicant." Office Action dated July 3, 2006, p. 3. However, claim 1, as amended on August 5, 2005, claims

a reversible track defining a first channel having a first opening and a second channel having a second opening, said first opening defining *a first configuration* adapted to receive a first rope arrangement, said second opening defining *a second configuration* adapted to receive a second rope arrangement[.]

See Amendment dated Aug. 5, 2005, claim 1 (emphases added). This quite clearly covers channels (and openings within said channels) that have differing configurations. Claim 12, as amended, claims

a reversible track defining a first channel having a first opening, a second channel having a second opening and a rope passage, one of said first channel and said rope passage *configured for receiving a leg of a rope* attached to an edge of a pool cover, and the other one of said first channel and said rope passage *configured for receiving a return leg of the rope*, said second channel *configured for receiving a portion of a slider* attached to a pool cover[.]

See Amendment dated Aug. 5, 2005, claim 12 (emphases added). The first channel is configured for receiving either a leg or a return leg of a rope, and the second channel is configured for receiving a portion of a slider. *Id.* Thus, claim 12 also quite clearly covers channels that have different configurations.

Furthermore, the fundamental canons of claim construction support the Appellant's argument. In making his rejection, the Examiner did not take into account the manner in which disputed claim terms are construed, and the extent to which the disclosure in the specification informs the meaning of those claim terms. When construing the scope and meaning of the claims, the specification is of particular significance to the claim construction process, as claims "must be read in view of the specification, of which they are a part." *Markman v. Westview Instruments*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996). "The close kinship between the written description and the claims is enforced by the statutory requirement that the specification describe the claimed invention in 'full, clear, concise, and exact terms.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (en banc), *cert. denied*, 126 S. Ct. 1332 (2006) (quoting 35 U.S.C. § 112, ¶ 1). Therefore, "the specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

As a matter of claim interpretation, the claim terms "first configuration," "second configuration," "configured for receiving a leg of a rope," "configured for receiving a return leg of the rope," and "configured for receiving a portion of a slider" should be construed commensurate with the scope of the disclosure in the specification. In the specification of the present Application, the Appellant discloses and claims embodiments of the invention that clearly contemplate the first and second channels having different configurations. *See, e.g.*, Fig. 5 of Application (wherein the first channel is numbered 64 and the second channel is numbered 70). It would be improper to limit the language of the claims to identically-configured channels when the specification and drawings indicate possession and disclosure of a broader concept of

the invention. When construed in light of the disclosure, the claims cover differently-configured channels.

The Last Reference, on the other hand, discloses a coping assembly having channels that are configured identically. For example, in Figure 3A of the Last Reference, openings 17 and 21 of channels 16 and 19, respectively, are identical to each other and only adapted to receive a single rope arrangement. One of ordinary skill in the art would not understand the Last Reference to teach or suggest differently-configured channels. *See Holmes Declaration*, ¶ 5. Indeed, the Last '990 patent explicitly notes the advantages of a symmetrical configuration. Col. 6, ll. 61-65.

However, the Examiner has rejected the claims repeatedly, regardless of the claims' scope. For example, in the Office Action dated Feb. 14, 2006, the Examiner states that "Last teaches at lines 42-53 of column 12 the track and coping assembly can be used with different cover configurations." Office Action dated Feb. 14, 2006, p. 4. He further argued that this portion of the Last Reference's specification discloses material identical to that shown in paragraph 0052 of the Application, and rejected all the claims on the bases of § 102(a) and (e). *Id.*

However, the Examiner's citation of the Last Reference does not show that the Last Reference discloses each and every limitation recited in the claims, as required for anticipation. *Trintec Industries, Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002). Column 12, lines 42-53 simply recite that those skilled in the art can specify "different cross section configurations... which perform substantially the same function, in substantially the same way, to achieve substantially the same result as those components described and specified above for the invented track construct component system." Last Reference, Col. 12, ll. 48-53. In the cited

portion of the Last Reference's specification, there is no disclosure of two channels wherein each channel has a different configuration for different rope arrangements. There is only a statement about what one of ordinary skill in the art could envision. This is irrelevant to a § 102 (a) or (e) anticipation rejection.⁶ Thus, the Examiner's argument that the Last Reference literally anticipates the Application's claims is incorrect: even the broad statement of contemplated "different configurations" does not disclose, teach or suggest one track with a first configuration adapted for one rope arrangement and a second configuration adapted for a second, different rope arrangement.

Even if the Examiner were attempting to use the doctrine of inherent anticipation as a basis for his rejection of the claims, such a rejection cannot stand. "Inherent anticipation requires that the missing descriptive material is 'necessarily present,' not merely probably or possibly present, in the prior art." *Id.* (citations omitted). The two channels disclosed in the Last Reference do not *necessarily* have different configurations. While the Examiner appears to argue that those two channels could *possibly* be configured differently, this does not meet the requirements for an inherent anticipation rejection. *See id; see also id.* at 1297 ("Inherency does not embrace probabilities or possibilities."). As such, the Examiner's § 102(a) and (e) rejections cannot stand.

When one reflects on the significance of language in the cited portions of the Last Reference, the Examiner's error in making §102(a) and (e) rejections becomes even clearer.

⁶ This part of the Last Reference's specification thus merely states that those skilled in the art could envision configurations that would satisfy a doctrine of equivalents test in an infringement analysis. *See, e.g., Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950) (stating that "a patentee may invoke this doctrine to proceed against the producer of a device 'if it performs substantially the same function in substantially the same way to obtain the same result'"') (internal citation omitted). Such an analysis is unrelated to an anticipation rejection. *See* discussion on p. 10-11, *infra*; *see also* n. 8, *infra*.

Literal infringement and anticipation are analytically identical; that is, one determines both anticipation and infringement based on the requirement that a certain device or reference contains each and every limitation recited in the claims. *See V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1312 (Fed. Cir. 2005); *see also Trintec Industries*, 295 F.3d at 1295. Indeed, "that which [literally] infringes if later anticipates if earlier." *Polaroid Corp. v. Eastman Kodak Co.*, 789 F.2d 1556, 1573 (Fed. Cir. 1986) (quoting *Peters v. Active Manufacturing Co.*, 129 U.S. 530, 537 (1889)). However, the Last Reference language cited by the Examiner references only potential infringement under the doctrine of equivalents, which requires that the allegedly infringing device contain an element that, while not exactly identical to the claimed element, "performs substantially the same function in substantially the same way to achieve substantially the same result." *Graver Tank*, 339 U.S. at 608.⁷ The invalidity "mirror image" of doctrine of equivalents infringement would be obviousness, if anything,⁸ and the Examiner has made no obviousness rejections. *See* Office Action dated Feb. 14, 2006, p. 5. Furthermore, even if he had done so, it would have been inapposite under the circumstances, and the Holmes Declaration would rebut any possible §103 concerns.⁹

⁷ Of course, whether a certain element is "equivalent" or not is determined by whether one of ordinary skill in the art would consider it to be so. *Catalina Marketing International, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 812 (Fed. Cir. 2002).

⁸ *See Wilson Sporting Goods Co. v. David Geoffrey & Assoc.*, 904 F.2d 677 685 (Fed. Cir. 1990) (holding that an allegedly infringing golf ball does not infringe under a doctrine of equivalents analysis because, if the accused ball were prior art, the claims at issue would have been rejected as obvious in view of the accused golf ball), *overruled on other grounds*.

⁹ The configurations disclosed and claimed in the presently pending Application and the unspecified "equivalents" disclosed in the Last Reference can be equated *only if* one of ordinary skill in the art would find their differences to be insubstantial. *Catalina Marketing*, 289 F.3d at 812. The Examiner has provided no evidence that one of ordinary skill in the art would consider the Last Reference's channel configurations and the Application's channel configurations to be equivalent. On the other hand, Appellant submitted the Holmes Declaration on December 7, 2005, in which declarant Mr. Holmes stated that one of ordinary skill in the art would find the structures disclosed in the Last Reference and the structures disclosed in the Application to be entirely and substantially different, *see Holmes Declaration, ¶ 5*, not equivalent. The Examiner simply ignored this evidence. The Appellant's unrefuted evidence demonstrates that the claims in the Application would not infringe the Last

Footnote continued on next page . . .

Because the Application claims something distinct from that disclosed by the Last Reference, the Last Reference does not disclose (either literally or inherently) each and every element of the invention as claimed. Thus, the Examiner's § 102 (a) and (e) rejections of claims 1-17 cannot stand.

CONCLUSION: The Examiner's Rejection of Claims 1-17 Cannot Stand

In view of the foregoing, Appellant respectfully submits that the Examiner has failed to maintain proper rejections of claims 1-17. Therefore, each of Appellant's claims that previously were rejected should be allowed. Appellant further submits that the application, in its present form, is in condition for allowance. Such favorable action, after reexamination and reconsideration, is respectfully requested. In the event any extension of time or payment of fee is required, Appellant hereby conditionally petitions therefor and authorizes any charges to be made to Deposit Account 02-0390, BAKER & DANIELS.

Respectfully submitted,



Kevin R. Erdman
Registration No. 33,687

Attorney for Appellant

Enc. Return postcard

Reference's claims under the doctrine of equivalents – which means that the Last Reference also cannot be grounds for a §103 rejection.

(9)

APPENDIX

CLAIMS ON APPEAL

1. (Previously Presented) A universal track and coping assembly for use with swimming pool covers comprising:

a coping defining a slot having a slot opening for receiving a track, an inner wall and an opposite inner wall, either one of said inner wall and said opposite inner wall defining a coping tab projecting therefrom; and

a reversible track defining a first channel having a first opening and a second channel having a second opening, said first opening defining a first configuration adapted to receive a first rope arrangement, said second opening defining a second configuration adapted to receive a second rope arrangement, said second rope arrangement being different from the first rope arrangement, said reversible track insertable into said slot, whereby either one of said first opening and said second opening faces in the same direction as said slot opening, and whereby said coping tab keeps said reversible track from sliding out of said slot opening.

2. (Original) The universal track and coping assembly of claim 1 further comprising at least one insert plate insertable into said slot between said reversible track and one of said inner walls of said coping, said at least one insert plate keeping said reversible track pressed against the other one of said inner walls.

3. (Original) The universal track and coping assembly of claim 2, wherein said insert plate is a wedge.

4. (Original) The universal track and coping assembly of claim 2, wherein said reversible track further defines two locking ledges positioned such that one of said ledges interlocks with said coping tab to keep said reversible track from sliding out of said slot opening.

5. (Original) The universal track and coping assembly of claim 4 wherein at least one of said locking ledges includes a track tab projecting from said reversible track.

6. (Original) The universal track and coping assembly of claim 1, wherein one of said first channel and said second channel is configured for receiving a rope attached to an edge of a pool cover, and the other one of said first channel and said second channel is configured for receiving a return leg of the rope.

7. (Original) The universal track and coping assembly of claim 6 further comprises a pulley attached to said track for receiving and changing direction of said rope.

8. (Original) The universal track and coping assembly of claim 7 further comprises a pulley housing for receiving said pulley, said housing attached to said track.

9. (Original) The universal track and coping assembly of claim 8, wherein said pulley housing defines a passageway for receiving said pulley and releasing said pulley from said pulley housing.

10. (Original) The universal track and coping assembly of claim 1, wherein said second channel is configured to receive a rope and a slider attached to an edge of a pool cover.

11. (Previously Presented) The universal track and coping assembly of claim 1, wherein said coping is adapted to attach to a deck of a pool.

12. (Previously Presented) A universal track and coping assembly for use with swimming pool covers comprising:

a coping defining a slot having a slot opening for receiving a reversible track, wherein said coping defines an inner wall and an opposite inner wall, either one of said inner wall and said opposite inner wall defines a coping tab projecting therefrom;

a reversible track defining a first channel having a first opening, a second channel having a second opening and a rope passage, one of said first channel and said rope passage configured for receiving a leg of a rope attached to an edge of a pool cover, and the other one of said first channel and said rope passage configured for receiving a return leg of the rope, said second channel configured for receiving a portion of a slider attached to a pool cover, said second opening defining a perimeter configured to complement the slider, said reversible track

insertable within said slot, whereby either one of said first opening and said second opening faces in the same direction of said slot;

at least one insert plate insertable into said slot and between said reversible track and one of said inner walls of said coping, for keeping said reversible track pressed against the other one of said inner walls.

13. (Original) The universal track and coping assembly of claim 12, wherein said reversible track further defines two locking ledges positioned such that one of said ledges interlocks with said coping tab to keep said reversible track from sliding out of said slot opening.

14. (Original) The universal track and coping assembly of claim 13 wherein at least one of said locking ledges includes a track tab projecting from an outer surface of said reversible track.

15. (Original) The universal track and coping assembly of claim 12 further comprises a pulley attached thereto for changing a direction of said rope.

16. (Original) The universal track and coping assembly of claim 15 further comprises a pulley housing for receiving said pulley, said housing attached to said reversible track.

17. (Original) The universal track and coping assembly of claim 16, wherein said pulley housing defines a passageway having a passageway opening for receiving said pulley and releasing said pulley from said pulley housing.

APPENDIX

EVIDENCE APPENDIX

Declaration of Bruce Holmes (attached), recognized by the Examiner in the Office Action dated February 14, 2006.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/735,144	Confirmation No. 1570
Applicant	:	Michael J. Shebek	
Filed	:	12/12/2003	
Art Unit	:	3751	
Examiner	:	Robert M. Petsuga	
Docket No.	:	APC-P0002-01	
Customer No.	:	27268	

DECLARATION OF BRUCE HOLMES

I, Bruce Holmes of 20 Fairlane Drive, Brownsburg, Indiana 46112, declare as follows:

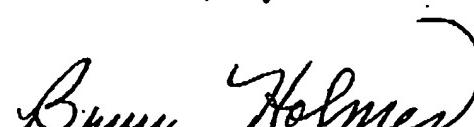
1. I have over twenty-one (21) years of experience of installing and servicing pools for a leading company that installs hundreds of pools a year and related equipment including automatic pool covers.
2. I have studied the disclosure of the above-identified patent application and the disclosure of U.S. Patent No. 6,496, 990 to Last (the "Last Patent").
3. In accordance with my understanding of the pool industry and the structures involved, it is my opinion that a track and coping of the above-identified application may be constructed with or without an insert plate as disclosed in the application. It is well known in the industry that different sizes and shapes of tracks in coping may be used, and material thicknesses in each may be varied. Typically, but not exclusively, an insert plate is used as a locking mechanism because an insert plate may be easily removed for servicing the track then reinserted to lock the track. However, it is also understood that in some environments an insert plate would not be desired, in which case the material thicknesses would be varied to obviate the need for an insert plate. Accordingly, it is my opinion that an artisan of ordinary skill in the pool equipment installation industry would recognize that the invention of the above-identified patent application could be implemented with or without an insert plate.
4. I have also reviewed the disclosure of Fig. 6 and the alternative terminology of a plate or a wedge in the disclosure of the above identified application. It is my opinion that one of ordinary skill in the pool equipment installation industry would recognize that a wedge may have a slight taper that is not visibly discernible from a plate. In certain configurations a wedge may be preferred, in others a plate. In the context of using the plate or wedge to lock in the track, the

wedge would necessarily have only a slight taper. Accordingly, it is my opinion that an artisan of ordinary skill in the pool equipment installation industry would recognize the alternative structures possible for an insert plate as disclosed in Fig. 6.

5. I have studied the disclosure of the Last Patent, including the text in column 12 lines 42-53, and it is my opinion that the Last Patent contains no teaching or suggestion that the two C channels of the cover track would have configurations different from each other. Rather, it is my opinion that the entire disclosure of the Last Patent teaches and suggests that the C channels would be mirror images to accommodate the disclosed rope arrangement. The noted portion of the disclosure of the Last Patent does teach that the extruded longitudinal track does not necessarily require a C channel configuration, but it is my opinion that the Last Patent contains no teaching or suggestion that the opposite channels would be anything other than an identical or mirror image of each other. In the pool equipment installation industry, tracks are designed to fit the particular pool cover rope arrangement that is sold with the tracks. The invention of the above identified application uniquely provides an arrangement that accommodates different rope configurations in the differently configured channels, which neither the Last Patent nor other known track configurations provide. This universal tracking arrangement allows an installer to have just one type of track and still accommodate the various rope arrangements of different pool covers, and it is my opinion that this departure from the teachings of the Last Patent is a non-obvious modification that is neither taught nor suggested by any prior art of which I am aware.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

And further, I sayeth not.



Bruce Holmes

Date: 12/6/05

APPENDIX

RELATED PROCEEDINGS APPENDIX

None